

*APPELLENT'S REPLY*

The Applicants will not address every ground of rejection, and in particular, it is felt that the art-based rejections have been fully and accurately briefed and that a favorable decision on the claims on that basis is warranted.

Regarding the rejections under section 101 and 112, the Applicants do however wish to respond to the Examiner's Answer, as there appears to be some confusion that may be propagated in the absence of a response.

**Rejection of claims 16-19 and 21-32 under 35 USC 101**

Regarding these rejections, the appellant had previously noted that "receiving or transmitting work electronically" is significant to the invention (i.e., it is not *insignificant* extra solution activity). The examiner now asserts that sending and receiving of the work is *not* significant to the invention. The examiner opined that in this regard, the true significance of the invention lies in the determination of work and the selection of the candidate who can perform the needed work.

However, it is apparent that the invention fails to function and cannot serve its purpose without the sending and receiving aspects, such that these steps are indeed not only significant to the invention, but critical to the inventions very ability to operate. The invention, after all, pertains to "accessing, engaging and managing human resources," none of which will be possible within the invention without the sending and receiving steps of functionality. Thus, the Examiner's opinion that these steps may be ignored or omitted appears to be unsupported by the facts as they stand.

Regarding claim 16, the examiner makes much of the fact that the claim does not claim that the work *is* being sent electronically over a network but rather that the work is "*capable*" of being sent over the internet to an employer computer system. Of course, a limitation as to an element's required capabilities is a positive recitation like any other quality of an object or element (height, weight, etc.). Put another way, if the recited element *did not* have the indicated capability, i.e., if it were *incapable* of such transmission, as many items of work are, then the system would entirely fail. Thus, it is not clear why the examiner insists that such limitations are insignificant and should be ignored.

It is noted that the Examiner's answer was prepared before the recent Supreme Court Bilski decision and the PTO's new guidance in light of that decision, and so the unfortunate timing of the Examiner's Answer may explain the lack of recognition of these plainly important claim limitations.

#### **Rejection of Claims 21-32 under 35 USC 112 1st Paragraph**

The examiner admits that one of skill in the art would fully understand what is meant by "independent contractor," but insists that the specification does not support this limitation. As previously noted, the specification amply describes individuals whose jobs have certain characteristics, and as admitted by the Examiner, those characteristics make such individuals Independent Contractors by definition. If the Examiner's objection is that the precise term "independent contractor" does not appear in the specification, it will be appreciated that this point is irrelevant. As the Board will appreciate, Federal Law does not require *in hac verbis* recitation. There is no doubt, even by the Examiner, that the individuals discussed in the specification are independent contractors by definition. Therefore, referring to them as such in the claims is fully supported.

The examiner seems to attach significance to the fact that the appellant has given a definition of an "independent contractor" vs. an "individual independent contractor." Of course, the term of interest is "independent contractor." The term "*individual* independent contractor" is not some new concept; it simply means *one* of these (as opposed to *10* of these, or *500* of these).

The Federal Circuit places the burden on the *Examiner* to establish the lack of written description. *See In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578, 1583-4 (Fed. Cir. 1996). Where, as here, "the specification contains a description of the claimed invention, albeit not *in ipsis verbis* (in the identical words), **then the examiner or Board**...must provide reasons why one of ordinary skill in the art would not consider the description sufficient." *Id.* (emphasis added). In the present case, the Examiner has not offered any evidence or reasoning to meet the Office's burden, and the rejection of claims 21-32 for lack of written description under 35 U.S.C. § 112 should be reconsidered and withdrawn.

### *Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance, and request reversal of the rejections and remand of the application to the Examiner.

Respectfully submitted,



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Date: August 24, 2010